

ORIGINAL

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES

In Re Application of:

Thomas D. Petite

Serial No.: 08/825,576

Filed: March 31, 1999

For: **Transmitter for Accessing Automated
Financial Transaction Machines**

Examiner: F.L. Evans

Art Unit: 2877

Docket: 81607-1010

Appeal No. _____

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, postage prepaid, in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231, on July 9, 1999.



Signature - Daniel R. McClure

SUBSTITUTE APPEAL BRIEF UNDER 37 C.F.R. §1.192

Honorable Commissioner of
Patents and Trademarks
Washington, D.C. 20231

Sir:

This is an appeal from the decision of Examiner F.L. Evans, Group Art Unit 2877,
finally rejecting all of the claims in the present application and making the rejection final.

I. REAL PARTY IN INTEREST

The real party in interest of the instant application is StatSignal Systems, Inc., a Georgia corporation, having its principal place of business in Atlanta, Georgia.

II. RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences.

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III. STATUS OF THE CLAIMS

Claims 1-20 were canceled during the prosecution of this application. Claims 21-25 currently are pending in the application. The Office Action mailed on December 14, 1998 finally rejected claims 21-23 and 25 under 35 U.S.C. §103(a) as being unpatentable over Tait, et al., of record, in view of Waraksa, et al., (U.S. Patent No. 5,319,364) cited by Applicant. The Office Action also rejected claim 23 under 35 U.S.C. §112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one of ordinary skill in the art that the inventor, at the time the application was filed, had possession of the claimed invention. Additionally, the Office Action finally rejected claim 24 under 35 U.S.C. §103(a) as being unpatentable over Tait, et al. in view of Waraksa, et al. as applied to claims 21-23 and 25, and further in view of a February 19, 1997 article from the online publication of *The Augusta Chronicle* entitled, "Device Could speed Up Visits To Gas Stations", by Wollenberg.

IV. STATUS OF AMENDMENTS

On January 14, 1999, Applicant submitted an After-Final Amendment and Response to the Final Office Action of December 14, 1998. In an Advisory Action mailed from the U.S. Patent and Trademark Office on February 2, 1999, the Examiner indicated that the pending rejections of claims 21-25 under 35 U.S.C. §112, second paragraph, were overcome by Applicant's after-Final Amendment, and that the after-Final Amendment would be entered in the record after the filing of the Notice of Appeal. Therefore, all amendments submitted should now be entered.

V. SUMMARY OF THE INVENTION

The present invention is generally directed to a system (FIG. 1) for providing remote access to a automated financial transaction machine 10. (page 11, lines 6-14). In accordance with one aspect of the invention, the system includes an automated financial transaction machine 10, and receiving means 18 provided at the automated financial transaction machine for receiving data transmitted via electromagnetic waves 30. (page 8, line 6 - page 9, line 12). Although not necessary for the invention, in a preferred embodiment, the automated financial transaction machine includes a card reader 14 for receiving and reading magnetically encoded cards (not shown). (page 7, line 15 - page 8, line 5). In this embodiment, the receiving means 18 is operatively and electrically connected to the magnetic card reader 14, so as to allow the system to operate either by access from a remote transmitter or by way of an inserted card. (page 7, line 15 - page 8, line 5).

As shown in FIG. 2, the system of the invention further includes a remote access unit 20 having a memory 42 configured to store user identification data 94 (FIG. 4), including track 1 and track 2 data, and a low-power transmitter 48 adapted to transmit the user identification data to the receiving means. (page 8, line 6 - page 12, line 16). As shown in FIG. 2, as well as depicted functionally in FIG. 3, the remote access unit is manually operated by a transmit button 22, which, when depressed, causes a controller 46 to retrieve user identification data from the memory 42 and transmit the user identification data from the low-power transmitter 48. (page 12, lines 3-14). As shown in FIG. 4, in addition to the user identification data, the transmitter also transmits synchronization bits 92 and a function code 96 that specifies a function that is to be performed. (page 16, lines 5-20).

In some embodiments of the invention, the controller is configured to transmit at least one checksum bit 98 (FIG. 4) for error correction (page 17, lines 1-3).

In some embodiments of the invention, the function code can define automated financial transaction machine access, a test code, an automobile lock, a distress call, *etc.* (page 16, lines 16-20, and page 17, lines 4-9).

Additionally, in some embodiments of the invention, a network can be provided for communicating the user identification data to a remote location (page 17, lines 9-14).

VI. CONCISE STATEMENT OF THE ISSUES PRESENTED FOR REVIEW

The issue in this appeal is whether claims 21-25 are unpatentable under 35 U.S.C. §103(a) and, additionally, whether claim 23 is unpatentable under 35 U.S.C. §112, first paragraph.

VII. GROUPING OF THE CLAIMS

The claims generally can be divided into four (4) claim groupings, as set out below. For purposes of the argument set forth in this appeal brief, one claim from each group will be evaluated and discussed in connection with the prior art. The claim groups include:

- (1) Claim Group I, which comprises claims 21-22
- (2) Claim Group II, which comprises claim 23;
- (3) Claim Group III, which comprises claim 24, and;
- (4) Claim Group IV, which comprises claim 25.

Reasons that Claim Groups Do Not Stand or Fall Together

Although, in reality, all claims of an application are distinct, Applicant has grouped the claims of the present application into three distinct claim groups. One claim for each group has been chosen as the exemplary claim. The reason that these claims for any given

group do not stand or fall with any claims of another group is, ultimately, because they are of differing scope. This differing scope is more specifically set out below.

In regard to Claim Group I, claim 21 is directed to a remote access device for accessing a financial transaction machine. The device includes "a single user depressable button; a memory configured to store user identification data, including track 1 and track 2 data; a low power transmitter; and a controller." The controller is configured "to control the transmitter to transmit the track 1 and track 2 data in direct response to a manual depression of the user depressable button, without any verification of user identification data."

Additionally, the controller also is configured "to control the transmitter to transmit a plurality of synchronization bits, track 1 and track 2 data, and a function code that identifies a transmitted function." The device defined by the elements recited above sufficiently differentiate the scope of the invention from the claims of the other claim groups such that this claim warrants separate consideration. Therefore, the claims of Claim Group I should properly stand or fall independently of claims of the other claim groups.

In regard to Claim Group II, claim 23 is a dependent claim depending from claim 21, and which further recites the function code defining "a function selected from the group consisting of: automatic financial transaction machine access, a test code, an automobile lock, and a distress call." The device defined by the element recited above sufficiently differentiates the scope of the invention from the claims of the other claim groups such that this claim warrants separate consideration. This contention is supported by the rejection of this claim based upon 35 U.S.C. §112, first paragraph, a rejection which is not standing against any of the claims of the other claim groups. Therefore, the claim 23 should properly stand or fall independently of claims of the other claim groups.

In regard to Claim Group III, claim 24 recites a remote access device incorporating the structural feature of being "configured for attachment to a key ring." Since this claim defines a separate structural aspect of the invention that renders it separately patentable from the claims of the other claim groups, this claim does not stand or fall together with a claim from any other claim group. Furthermore, Applicant submits that one of the references that was relied upon to form the combination of references under 35 U.S.C. § 103(a) does not constitute prior art. As a result, the rejection of claim 24 is legally deficient, and this claim patently defines over the prior art of record for at least this additional reason. Therefore, the claim 24 should properly stand or fall independently of claims of the other claim groups.

Finally, in regard to Claim Group IV, claim 25 defines a system for providing cardless access to a financial transaction machine. The machine includes "a remote access device having a single user depressable button, a memory configured to store user identification data, including track 1 and track 2 data, and a function code, a low power transmitter, and a controller configured to control the transmitter to transmit the track 1 and track 2 data and function code in direct response to a manual depression of the user depressable button, without any verification of user identification data." Additionally, the machine includes "an automated financial transaction machine having a magnetic card reader and receiving means for receiving data transmitted from the remote access device via electromagnetic waves, the receiving means being operatively and electrically connected to the magnet card reader." A network for communicating user identification data to a remote location also is included. Accordingly, claim 25 should properly stand or fall independently of claims of the other claim groups.

VIII. ARGUMENT

A. Rejections Under 35 U.S.C. § 112, First Paragraph

The Office Action rejected claim 23 under 35 U.S.C. § 112, first paragraph, stating that the specification failed to demonstrate that the Applicant had possession of the invention at the time the application was filed. Applicant respectfully traverses this rejection, noting appropriate locations of the specification, which provide adequate (indeed virtually verbatim) support for this claim language. In this regard, Applicant refers to section D-2 below, where this issue is discussed in more detail (in connection with the rejection of claim group II).

B. Rejections Under 35 U.S.C. § 103(a)

Before specifically discussing the rejections of each of the individual claim groups on a substantive basis, Applicant wishes to first set out the relevant case law regarding rejections under 35 U.S.C. § 103(a), which case law is relevant to each of the substantive arguments advanced in reference to each of the claim groups. As will be discussed in more detail below, Applicant submits that the rejection advanced by the Examiner is legally deficient, and, therefore, should be overturned as a matter of law. In this regard, the Examiner failed to advance a *prima facie* rejection, by: (1) failing to cite a suggestion or motivation to combine the references that allegedly render the presently claimed invention obvious, and; (2) failing to present a combination of properly combined references which render obvious every element of Applicant's claimed invention.

The law is well settled that, in order to properly support an obviousness rejection under 35 U.S.C. § 103, there must have been some teaching in the prior art to suggest to one skilled in the art that the claimed invention would have been obvious. *W. L. Gore & Associates, Inc. v. Garlock Thomas, Inc.*, 721 F.2d 1540, 1551 (Fed. Cir. 1983). More significantly,

"The consistent criteria for determination of obviousness is whether the prior art would have suggested to one of ordinary skill in the art that this [invention] should be carried out and would have a reasonable likelihood of success, viewed in light of the prior art. ..." Both the suggestion and the expectation of success must be founded in the prior art, not in the applicant's disclosure... In determining whether such a suggestion can fairly be gleaned from the prior art, the full field of the invention must be considered; for the person of ordinary skill in the art is charged with knowledge of the entire body of technological literature, including that which might lead away from the claimed invention."

(Emphasis added) In re Dow Chemical Company, 837 F.2d 469, 473 (Fed. Cir. 1988).

In this regard, Applicant notes that there must not only be a suggestion to combine the functional or operational aspects of the combined references, but that the Federal Circuit also requires the prior art to suggest both the combination of elements and the structure resulting from the combination. *Stiftung v. Renishaw PLC*, 945 Fed.2d 1173 (Fed. Cir. 1991). Therefore, in order to sustain an obviousness rejection based upon a combination of any two or more prior art references, the prior art must properly suggest the desirability of combining the particular elements to create a remote access device comprising a memory configured to store user identification data, including track 1 and track 2 data, as claimed by the Applicant.

It is not the Applicant's burden to prove that no teaching, suggestion, or motivation exists within the prior art that would lead one of ordinary skill to make the particular combination of elements. Instead, the initial burden is upon the Patent Office to establish a *prima facie* case of obviousness. Such a *prima facie* showing includes an identification of a proper suggestion or motivation within the prior art to make the combination.

For example, the Office Action concludes that "it would have been obvious to one with ordinary skill in the art to modify the teachings of Tait *et al.* with the teachings of Waraksa *et al* because transmission of a plurality of synchronization bits, a function code and an identification code was conventional in the art of remote access devices as evidenced by the disclosure of Waraksa *et al.*" (Office Action, p. 4, lines 6-10). As a matter of law, however, this fails to

provide the requisite suggestion, teaching, or motivation to selectively combine the independent teachings of Tait *et al.* and Waraksa *et al.* in the manner specifically claimed in independent claims 21 and 25, because the Office Action failed to answer certain basic questions.

Specifically, why would a person possessing the system of Tait *et al.* be motivated to modify the communication parameters of the system to provide the synchronization bits and function code of Waraksa *et al.*? Why would a person possessing the passive (*i.e.*, buttonless) transmission system of Waraksa *et al.* desire to add buttons to the system, or to configure the transmitter to transmit track one or track two data? Without the benefit of hindsight, such a motivation is simply not present within the prior art.

It is also well established law that, when combining references to form a rejection under 35 U.S.C. § 103(a), the references must, collectively, disclose every element of the rejected claim(s). *W. L. Gore & Associates, Inc. v. Garlock Thomas, Inc.*, 721 F.2d 1540, 1551 (Fed. Cir. 1983). As will be discussed below, the rejections set forth in the Office Action have failed to satisfy this most basic legal requirement.

1. Preliminary Discussion of 35 U.S.C. § 103 Rejections

Although Applicants have identified four separate and definable claim groupings, there are certain points and distinctions that apply to each claim grouping. The Final Office Action has rejected claims 21-23 and 25 under 35 U.S.C. § 103, as being obvious over the combination of Tait *et al.*, in view of Applicant's own disclosed prior art (Waraksa *et al.*), and claim 24 on the aforementioned combination of references in further view of Wollenberg. As fully discussed above, it is well established that a proper rejection of a claim under 35 U.S.C. § 103 requires that the prior art collectively disclose each element of the claim. See, *e.g.*, *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540 (Fed. Cir. 1983).

In short, Applicant's invention is directed to a system for providing remote access to a financial transaction machine and comprises a remote access device which has a memory configured to store user identification data, including track 1 and track 2 data and a function code. None of the asserted prior art references disclose or suggest an identification code which conveys or identifies any user specific or user identifying information, much less any track 1 or track 2 data. In particular, Waraksa, et al. merely incorporates an identification code or random binary value that is set to match a receiver in order to eliminate the activation of a keyless entry system.

Having set forth this fundamental distinction, each of the claim groupings will now be discussed.

C. Discussion of Claim Group I

Claim Group I comprises claims 21-22. Claim 21 is as follows:

21. A remote access device for accessing a financial transaction machine comprising:

- a single user-depressable button;
- a memory configured to store *user identification data, including track 1 and track 2 data*;
- a low-power transmitter; and
- a controller configured to control the transmitter to transmit the track one and track two data in direct response to a manual depression of the user-depressable button, *without any verification of user identification data*, the controller being configured to control the transmitter to *transmit a plurality of synchronization bits, track one and track two data, and a function code that identifies a transmitted function*.

(Emphasis added)

The applied prior art fails to disclose at least the collective features that are emphasized above. In particular, claim 21 defines the “user identification data” to specifically include track 1 and track 2 data. The Office Action, in contrast, has applied

Waraksa *et al.* as allegedly disclosing “a remote access device in which a transmitter transmits a plurality of synchronization bits, a function code **and an identification code.**” (Office Action, page 4, lines 2-3). Among other differences, the “identification code” of Waraksa *et al.* is significantly different that the “user identification data” defined in claim 21. In this regard, the “identification code” of Waraksa *et al.* is simply a random binary value that is set to match a receiver, simply to eliminate (or significantly reduce) the activation of the keyless entry system of Waraksa *et al.* by another that is toting a similar transmitter. Thus, the identification code of the system of Waraksa *et al.* conveys no “user” information, much less any track 1 or track 2 data, as specifically claimed in claim 21.

Indeed, Waraksa specifically states:

In addition, it will be appreciated that the 20-bit IDENTIFICATION code provides in excess of one million different ID codes, thereby significantly reducing the probability that two beacons with the same ID code will be present in the same vicinity at the same time.

(Waraksa, Col. 6, lines 3-8).

There is no disclosure or suggestion within Waraksa that the identification code convey or identify any user-specific or user-identifying information (much less any track 1 or track 2 data). Furthermore, the Office Action admits that, “Tait *et. al.* does not specifically disclose the transmission of a plurality of synchronization bits and a function code along with identification data (track 1 and track 2 data).” (Office Action, page 3, line 21 - page 4, line 1). Accordingly, and for this reason alone, the rejection under 35 U.S.C. § 103(a) should be removed, as collectively Tait *et al.* and Waraska *et al.* fail to disclose or suggest all elements of independent claim 21.

Furthermore, in addition to the foregoing distinction and forming an independent basis for patentability, claim 21 specifically claims that the invention includes a controller that is “configured to control the transmitter to transmit the track one and track two data in direct response to a manual depression of the user-depressable button, without any verification of user identification data.” There is no comparable disclosure or teaching within Tait *et al.* or Waraksa *et al.* Specifically, the system of Tait *et al.* requires the user to key in a PIN number to verify her identity to the transmitter, as a matter of improved security. However, the present invention provides a more user friendly transmitter, which presumes security, and transmits track one and track two data “without any verification of user identification data.” Accordingly, Tait *et al.* fails to disclose this claimed limitation. Likewise, Waraksa *et al.* fails to disclose this limitation, as the system of Waraksa *et al.* does not communicate track one or track two data (or any personal identification data for that matter). Thus, the Office Action has not identified teachings within the prior art references that disclose (or render obvious) all of the elements of claim 21.

Further, and as a separate and independent basis for the patentability of claim 21, the Office Action has failed to cite an appropriate suggestion, teaching, or motivation to combine the alleged teachings of the two references Tait and Waraksa. Waraksa is directed to a passive keyless entry system for an automobile. In contrast, Tait is directed to a wireless remote financial transaction system. Why would one be led to combine select features of these vastly different systems? The Office Action has failed to cite such a teaching, suggestion, or motivation. Indeed, Tait and Waraksa are directed to non-analogous art. Tait has been classified (and cross-referenced) in U.S. Classes 235/380, 235/379, and 235/382, while Waraksa has been classified (and cross-referenced) in U.S. Classes 340/825.72, 340/825.31, and 361/172. Thus, there is absolutely no overlap between the two classes in

which the two references are classified and cross-referenced. As a result, one would not be led to selectively combine the significantly divergent teachings of these two references in the manner claimed by the present invention.

If the Office Action's rejection of claim 21 is determined to be misplaced, then dependent claims 21 and 22 (Claim Group I) will be allowable, independent of the remainder of the claims. For at least this reason, claims 21-23 do not stand or fall with the claims of any other claim group.

D. Discussion of Claim Group II

Claim Group II comprises dependent claim 23. Dependent claim 23 is as follows:

23. The remote access device as defined by claim 22, wherein **the function code defines a function selected from the group consisting of: automatic financial transaction machine access, a test code, an automobile lock, and a distress call.**

(Emphasis Added)

The Office Action rejected claim 23 on independent bases, including 35 U.S.C. 103(a) and 35 U.S.C. §112, first paragraph.

1. Rejections under 35 U.S.C. § 103(a)

With regard to the rejection under 35 U.S.C. § 103(a), the applied prior art fails to disclose at least the collective features that are emphasized above. In addition, and for the reasons set forth with respect to claim group I, the prior art failed to properly disclose the elements of claim 22, from which claim 23 depends. The arguments set forth above with respect to claim group I are hereby incorporated herein by reference. In addition, claim 23 defines the function code as a function selected from the group consisting of: automatic financial transaction machine access, a test code, an automobile lock, and a distress call. These features are not disclosed within the prior art of record.

As an independent basis for the patentability of claim 23, the Office Action failed to cite a legally sufficient teaching, suggestion, or motivation to combine Tait and Waraksa. In this regard, Applicant hereby repeats and realleges the arguments advanced in connection with Claim Group I, namely, the failure of the Office Action to advance a proper motivation, suggestion, or teaching to combine Tair and Waraksa.

2. Rejection under 35 U.S.C. § 112, First Paragraph

In addition, the Office Action rejected claim 23 under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention. In support of this contention, the Office Action directed the Applicant's attention to page 17, lines 4-13 of the specification for the proposition that the specification "was silent with respect to a remote access device for accessing a financial transaction machine comprising a single user-depressible button and a function code selected from a group consisting of: automatic financial transaction machine access, a test code, an automobile lock, and a distress call." (Office Action of December, 14, 1998, page 2, lines 12-16). However, it appears that the Examiner failed to consider that the specification describes the claimed function code, and in particular, refers to the function codes in terms of a function byte. Specifically, page 16, lines 15-19 provides:

Following the data bytes 94 is a function byte 96. This byte includes bits that identifies the transmitted function. For example, whether the function is an ATFM access, a *text** code, automobile lock, a distress call (in the embodiment discussed below), *etc.* It also includes test bits that are use if the function is a test sequence.

*Note: the term "text" is now "test" by virtue of the correction of a typographical error by amendment to the specification filed on January 14, 1999.

Additionally, it appears that the Examiner has failed to recognize that the single user-depressible button element of the invention as claimed in claim 23 is but one embodiment of the invention described in the specification. For instance, at page 17, lines 4-5, as referenced by the Examiner in the rejection under 35 U.S.C. § 112, first paragraph, the specification states that “in one embodiment, the invention may provide multiple functionality through the utilization of multiple transmit buttons.” Thus, the Applicant assumes that the Examiner takes the position that the single user-depressible button element has been neither disclosed nor enabled. However, as also disclosed in the originally filed application (page 8, line 21 - page 9, line 10):

A transmit button 22 is provided for the user. As illustrated in the preferred embodiment, the transmitter 20 is quite small and may be conveniently attached, for example, to a key ring for ready and portable use. Indeed, in one embodiment, the single transmitter constructed in accordance with the present invention may serve multiple functions. For example, small transmitters of this type are known for activating and deactivating automobile alarm systems. The transmitter of the present invention may be integrally designed with such an automobile remote to provide the dual functionality of remotely controlling an automobile alarm along with the functionality of remote access to an AFTM 10. In accordance with such an embodiment, a second transmit button 24 would be provided. In this regard, the first transmit button 22 would be operative to, for example, operate the AFTM 10, while the second transmit button 24 would be operative to remotely operate the automobile alarm.

(Emphasis Added)

Thus, multiple embodiments of the invention are disclosed in the specification, not merely the best mode contemplated by the inventor for carrying out the invention, including single-button, single-function embodiments, and multi-button, multi-function embodiments. Accordingly, the originally-filed specification provides adequate support (in fact, a virtually verbatim recitation) for the language of claim 23. Therefore, Applicant respectfully submits that claim 23 contains subject matter which was described in the specification.

Additionally, Applicant respectfully submits that the aforementioned passage from the specification reveals that “small transmitters of this type are known for activating and deactivating automobile alarm systems. . .”, and that the invention, as claimed in claim 23, is sufficiently enabled such that any person skilled in the art could make and use the subject matter of the invention.

For at least these reasons, the Applicant respectfully asserts that the Office Action’s rejection of claim 23 is misplaced and, therefore, should be removed. If the Office Action’s rejection of claim 23 is determined to be misplaced, then claim 23 (Claim Group II) will be allowable, independent of the remainder of the claims. For at least this reason, the claim of Claim Group II does not stand or fall with the claims of any other claim group.

E. Discussion of Claim Group III

Claim Group III comprises dependent claim 24. Dependent claim 24 is as follows:

24. The remote access device as defined by claim 21, **wherein the remote access device is configured for attachment to a key ring.**

(Emphasis Added)

The Office Action rejected claim 24 as being unpatentable over Tait *et al.* in view of Waraksa *et al.* as applied to claim 21, in further view of Wollenberg. Wollenberg is an article from the online publication of The Augusta Chronicle, which article was published on February 19, 1997.

Applicant respectfully submits that, as a matter of law, Wollenberg does not constitute prior art that can be used as a proper basis for rejecting claim 24. In this regard, Wollenberg is a publication that was retrieved from the Internet, and has a publication date of February 19, 1997. The present application, however, claims the benefit of U.S. Provisional Patent Application Serial No. 60/040,316, which was filed on February 14, 1997. Therefore, the filing date of the present application predates the publication date of Wollenberg. As a result, Wollenberg does not constitute prior art to the present application and, therefore, cannot properly be used to reject claims herein.

This result is a legal result, and is not affected by statements made within the article itself. First of all, any such internal statements cannot be used to properly support a claim rejection. Specifically, and from an evidentiary standpoint, such statements amount to hearsay, and cannot be used as proof that, in fact, such a system was in public use as of that date. To better illustrate this point, simply consider the alternative. A company could simply monitor the patent portfolio of a competitor. After noting the issuance of a significant patent, the company could simply publish an article, a statement, a press release, etc., stating that they have been in possession of a product or system, of the type covered by the patent. The company (or any third party) could then request re-examination of the patent on the basis of the statements made in the later-published article. Although this example presumes wrong-doing on the part of the company (assuming the published statements were false), the U.S. Patent Laws regarding prior art are crafted to avoid the harsh results that may otherwise result from such wrong-doing.

Furthermore, and as it specifically relates to the Wollenberg article, the article expressly stated that “Moblie Corp. plans to introduce in May, an electronic gizmo that can be clipped to a key chain and uses radio signals that activate the gas pump ...” Thus, by admission, the devices were not yet (as of the publication date) publicly available. Although the article noted that Mobile had been testing the devices since August 1996, there is no indication as to the confidentiality that may have been associate with the test group. If, in fact, the test group were to maintain the devices in confidentiality, then even the act of testing itself would not constitute prior art, as the devices/actions would have been “suppressed” or “concealed” (See 35 U.S.C. § 102(g)). Nevertheless, the article itself does not constitute prior art, and the statements contained there cannot simply be presumed to be true.

Simply stated, the Wollenberg reference, as a matter of law, does not constitute prior art, and, therefore, should be removed from consideration. Moreover, the Examiner’s act of submitting the Wollenberg reference, implicitly reveals that the Examiner considered it necessary to point to a reference for the proposition that, “[a]t the time the invention was made, it would have been obvious to one with ordinary skill in the art to configure the device of Tait et al for attachment to a key ring/chain...” (Office Action, page 4, line 20 - page 5, line 1). The Examiner does, however, point to a passage in Tait et al, beginning at column 6, line 65, which states, "the size and shape of the transmitter may be varied and, in fact, depending on manufacturing technology, the transmitter may be credit card shaped to fit in a wallet or the like. The transmitter on such a credit card shape could also contain a key card and credit card selector keys." However, the only structure disclosed in the aforementioned passage is a credit card structure and not the key ring structure recited in claim 24.

Accordingly, the prior art of record fails to disclose the “key ring” attachment limitation that is highlighted above.

As an independent basis for the patentability of claim 24, the Office Action failed to cite a legally sufficient teaching, suggestion, or motivation to combine Tait, Waraksa, and Wollenberg. In this regard, Applicant hereby repeats and realleges the arguments advanced in connection with Claim Group I, in this regard. Namely, the failure of the Office Action to advance a proper motivation, suggestion, or teaching to combine Tair and Waraksa.

If the Office Action's rejection of claim 24 is determined to be misplaced, then claim 24 (Claim Group III) will be allowable, independent of the remainder of the claims. For at least this reason, the claim of Claim Group III does not stand or fall with the claims of any other claim group.

F. Discussion of Claim Group IV

Claim Group III comprises independent claim 25. Claim 25 is as follows:

25. A system for providing cardless access to a financial transaction machine comprising:

a remote access device having a single user-depressable button, ***a memory configured to store user identification data, including track 1 and track 2 data and a function code***, a low-power transmitter, and ***a controller configured to control the transmitter to transmit the track one and track two data and function code, in direct response to a manual depression of the user-depressable button, without any verification of user identification data***;

an automated financial transaction machine having a magnetic card reader and receiving means for receiving data transmitted from the remote access device via electromagnetic waves, the receiving means being operatively and electrically connected to the magnetic card reader; and

a network for communicating user identification data to a remote location.

(Emphasis Added).

As should be appreciated from the discussion hereinbefore, claim 25 is very similar to claim 21 and, therefore the arguments advanced in connection with claim 21 apply to claim 25 as well. In addition, claim 25 further defines a system for providing cardless access to a

financial transaction machine that incorporates a random access device. Accordingly, claim 25 defines over the prior art for all the same reasons advanced in connection with claim 21.

Specifically, the applied prior art fails to disclose at least the collective features that are emphasized above. Particularly, the identification code of the system of Waraksa *et al.* conveys no “user” information, much less any track one or track two data as specifically claimed in claim 25. Thus, the asserted prior art references do not render the invention as claimed in claim 25 obvious.

Additionally, claim 25 specifically claims a controller which is “configured to control the transmitter to transmit the track one and track two data in direct response to a manual depression of the user-depressable button and function code, without any verification of user identification data.” There is no comparable disclosure or teaching within Tait *et al.* or Waraksa *et al.* Specifically, the system of Tait *et al.* requires the user to key in a PIN number to verify her identity to the transmitter, as a matter of improved security. However, the present invention provides a more user-friendly transmitter, which presumes security, and transmits track one and track two data “without any verification of user identification data.” Accordingly, Tait *et al.* fails to disclose this claimed limitation. Likewise, Waraksa *et al.* fails to disclose this limitation, as the system of Waraksa *et al.* does not communicate track one or track two data. Thus, the Office Action has not identified teachings within the prior art references that disclose, or otherwise render obvious, all of the elements of claim 25.

Further, neither the device disclosed in Tait *et al.* nor Waraksa *et al.* discloses “a single user-depressable transmit button”. In fact, the device of Tait *et al.* requires a keypad of addition buttons in order that the user can key in her PIN number, as required by that system. In contrast, the system of Waraksa *et al.* discloses a keyless entry device that requires no user activation. In this regard, Waraksa *et al.* characterizes its system as “passive,” which operates

based upon motion detection and without affirmative user action. As long as the device is moving (*e.g.*, as a person is walking), it transmits a continuous electromagnetic signal of low power. When the user walks within approximately three feet of the automobile, the receiver (in the automobile) then detects the low power transmitted signal, and responds accordingly (*e.g.*, by unlocking the doors). What is significant, however, is that the system of Waraksa *et al.* requires no user-intervention, and therefore it lacks the “single user-depressable button” limitation, nor does it satisfy the limitation that the controller transmit the track one and track two data “**in direct response to a manual depression of the user-depressable button,**” of claim 25. Accordingly, and for at least this additional reason, Applicant respectfully submits that the rejection to independent claim 25 be removed.

Further, claim 25 defines a remote access device having both a magnetic card reader and a receiving means for receiving data from the remote access device. Claim 25 also defines a network for communicating user identification data to a remote location. Applicant respectfully submits that these additional limitations further distinguish claim 25 over the prior art of record.

As an independent basis for the patentability of claim 25, the Office Action failed to cite a legally sufficient teaching, suggestion, or motivation to combine Tait, Waraksa, and Wollenberg. In this regard, Applicant hereby repeats and realleges the arguments advanced in connection with Claim Group I, in this regard. Namely, the failure of the Office Action to advance a proper motivation, suggestion, or teaching to combine Tair and Waraksa.

For at least these reasons claim 25 is allowable. If the Office action’s rejection of claim 25 is determined to be misplaced, then claim 25 (Claim Group IV) will be allowable, independent of the remainder of the claims. For at least this reason, the claim of Claim Group IV does not stand or fall with the claims of any other claim group.

IX. CONCLUSION

Based upon the foregoing discussion, Appellant respectfully requests that the Examiner's final rejection of claims 21-25 be overruled and withdrawn by the Board, and that the application be allowed to issue as a patent with all pending claims 21-25.

A check in the amount of \$150 was enclosed with the filing of the original Appeal Brief. No additional fees are believed to be due in connection with this Substitute Appeal Brief. If, however, any additional fees are deemed to be payable, you are hereby authorized to charge any such fees to deposit account No. 20-0778.

Applicant received a Notification of Non-Compliance with 37 CFR 1.192(c), which was mailed on June 23, 1999, giving Applicant one month to correct noted deficiencies. This Substitute Appeal Brief, being filed on July 9, 1999, is timely filed, and no extensions of time are required. If, however, any extensions of time are determined to be required, they are hereby petitioned for, and you are hereby authorized to charge any such petition fees to deposit account No. 20-0778.

Respectfully submitted,



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IX. APPENDIX

Claims

21. A remote access device for accessing a financial transaction machine comprising:
- a single user-depressable button;
 - a memory configured to store user identification data, including track 1 and track 2 data;
 - a low-power transmitter; and
 - a controller configured to control the transmitter to transmit the track one and track two data in direct response to a manual depression of the user-depressable button, without any verification of user identification data, the controller being configured to control the transmitter to transmit a plurality of synchronization bits, track one and track two data, and a function code that identifies a transmitted function.
22. The remote access device as defined in claim 21, wherein the controller is further configured to control the transmitter to transmit at least one checksum bit for error detection.
23. The remote access device as defined by claim 22, wherein the function code defines a function selected from the group consisting of: automatic financial transaction machine access, a test code, an automobile lock, and a distress call.
24. The remote access device as defined by claim 21, wherein the remote access device is configured for attachment to a key ring.

25. A system for providing cardless access to a financial transaction machine comprising:

a remote access device having a single user-depressable button, a memory configured to store user identification data, including track 1 and track 2 data and a function code, a low-power transmitter, and a controller configured to control the transmitter to transmit the track one and track two data and function code, in direct response to a manual depression of the user-depressable button, without any verification of user identification data;

an automated financial transaction machine having a magnetic card reader and receiving means for receiving data transmitted from the remote access device via electromagnetic waves, the receiving means being operatively and electrically connected to the magnetic card reader; and

a network for communicating user identification data to a remote location.